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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,803	01/24/2002	Anthony Jabar JR.	099505 /51061	9378

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NIXON PEABODY LLP
101 Federal Street
Boston, MA 02110

EXAMINER

GRUNBERG, ANNE MARIE

ART UNIT	PAPER NUMBER
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1661

DATE MAILED: 07/15/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/056,803

Applicant(s)

Anthony Jabar et al.

Examiner

Anne Marie Grunberg

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE three MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on Apr 30, 2003
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above, claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s). 4 6) ☐ Other:

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0.DETAILED ACTION

Drawings

Color photographs and color drawings are acceptable only for examination purposes if a petition filed under 37 CFR 1.84(a)(2) is granted permitting their use as acceptable drawings. In the event that applicant wishes to use the drawings currently on file as acceptable drawings, a petition must be filed for acceptance of the color photographs or color drawings as acceptable drawings. Any such petition must be accompanied by the appropriate fee set forth in 37 CFR 1.17(h), three sets of color drawings or color photographs, as appropriate, and an amendment to the first paragraph of the brief description of the drawings section of the specification which states:

The patent or application file contains three drawings executed in color. Copies of this patent or patent application publication with color drawing(s) will be provided by the U.S. Patent and Trademark Office upon request and payment of the necessary fee.

Color photographs will be accepted if the conditions for accepting color drawings have been satisfied.

Objection to Disclosure

The disclosure is objected to because of the following informalities:

Applicants must fill in the blank on page 5, line 27 and page 16, lines 11 and 12 with the American Type Culture Collection accession number or date as appropriate.

Claim Rejections – Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982);

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In re Vogel, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-7 are provisionally rejected under the judicially created doctrine of obviousness-double patenting as being unpatentable over claim 1 of co-pending Application Number 09/999,733.

The claims in the present and co-pending application are drawn to the instant plant *Dendranthema x hybrida* 'MN98-89-7' wherein the plant, which includes seeds, pollen, ovule, and cuttings are claimed in the co-pending application. The subject matter of the instant claims 1-7 are encompassed by claim 1 of Application Number 09/999,733.

This is a provisional obviousness-type double patenting rejection because the co-pending application has not been allowed.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Enablement

Claims 1-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains,

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or with which it is most nearly connected, to make and/or use the invention. The specification does not disclose a reproducible method for making cultivar MN98-89-7. It is unclear what Applicants intend to deposit (seeds collected from cultivar MN98-89-7 or a seed which will grow into cultivar MN98-89-7). The first generation seeds collected from cultivar MN98-89-7 cannot be true to type because it is a hybrid. The chrysanthemum in general produces a wide range of distinctive features such as height, color, shape, hardiness, and many other characteristics. The offspring crossed from two desirable traits are unlikely to produce the same traits as the parents.

Fehr states on page 382, "Because the cultivars are highly heterozygous, a cultivar x cultivar cross results directly in a new segregating population." Since 'MN98-89-7' is a heterozygous population of seeds due to the hybridization between parent cultivar '92-321-19' and other unknown cultivars, it follows that 'MN98-89-7' is a segregating population. As a result, each deposited seed contains a unique genotype each different from the other seeds.

It does not appear that Applicants would be able to deposit seed, which will grow into cultivar MN98-89-7, since there is no indication that the parents are genetically uniform inbred lines. Therefore, the intended seeds to be deposited at the American Type Culture Collection cannot have the same features of cultivar MN98-89-7.

The invention employs novel plants, seeds, pollen, ovule and cuttings. Since the plants and seeds are essential to the claimed invention they must be obtainable by a repeatable method set forth in the specification or otherwise be readily available to the public. If they are not so obtainable or available, the requirements of 35 U.S.C. § 112, regarding "how to make" the invention may be satisfied by a deposit. The specification does not disclose a repeatable process to obtain the plants, seeds or plant parts, for the reasons set forth above. If the deposit is made under the terms of the Budapest Treaty, then an affidavit or declaration by applicants, or a statement by an attorney of record over his or her signature and registration number, stating that the specific plant line has been deposited under the Budapest Treaty and that it will be irrevocably and without restriction released to the public upon the issuance of a patent, would satisfy the deposit requirement made herein.

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If the deposit is not made under the Budapest Treaty, then in order to certify that the deposit meets the criteria set forth in 37 CFR 1.801-1.809, applicants may provide assurance of compliance by an affidavit or declaration, or by a statement by an attorney of record over his or her signature and registration number, showing that

- (a) during the pendency of this application, access to the invention will be afforded to the Commissioner upon request;
- (b) all restrictions upon availability to the public will be irrevocably removed upon granting of the patent;
- (c) the deposit will be maintained in a public depository for a period of 30 years or 5 years after the last request or for the effective life of the patent, whichever is longer; and,
- (d) a test of the viability of the biological material at the time of deposit (see 37 CFR 1.807); and,
- (e) the deposit will be replaced if it should ever become inviable.

Since the intended deposit of seeds will not yield cultivar MN98-89-7, Applicants should deposit regenerable tissues of cultivar MN98-M91-1 at a recognized depository of Applicants' choice, and include deposit information in claim 1. However, it is not clear at this time exactly what constitutes cultivar MN98-89-7 since it consists of a population of plants.

Written Description

Claims 7, 8, 10, 12-14 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

An applicant shows possession of the claimed invention by describing the claimed invention with all its limitations." MPEP 2163. "Possession may be shown in many ways. For example, possession may be shown by describing an actual reduction to practice of the claimed invention. Possession may

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also be shown by a clear depiction of the invention in detailed drawings or in structural chemical formulas which permit a person skilled in the art to clearly recognize that applicant had possession of the claimed invention." MPEP 2163

Claim 7 is drawn to hybrid Chrysanthemum seeds. The hybrid seeds of cultivar MN98-E90-15 do not appear to be supported by the description in the specification that the Applicants had possession of the claimed invention. Applicants have apparently not deposited any seeds of cultivar MN98-E90-15 because the Deposit Accession Number is left blank on page 16 of specification.

Claims 8, 10, 12, and 13 are drawn to the subsequent generation thereof cultivar MN98-E90-15 produced by hybridization with any and all chrysanthemum plants. No such hybrids have been described. *"A lack of adequate written description issue also arises if the knowledge and level of skill in the art would not permit one skilled in the art to immediately envisage the product claimed from the disclosed process."* MPEP 2163. *"The analysis of whether the specification complies with the written description requirement calls for the examiner to compare the scope of the claim with the scope of the description to determine whether applicant has demonstrated possession of the claimed invention....Generally, there is an inverse correlation between the level of skill and knowledge in the art and the specificity of disclosure necessary to satisfy the written description requirement. Information which is well known in the art need not be described in detail in the specification."* MPEP 2163.

Claim 13 is drawn to the family of chrysanthemum plant, which have characteristics such as shrub like habit, massive floral display, winter hardy to zone 3, frost tolerant to zone 3, and self-pinching. Claim 14 is drawn to viable chrysanthemum seeds, plants and succeeding generation thereof from intended seed deposited at American Type Culture Collection. However, the succeeding generation is not described in the specification. Applicants have described some characteristics, but many characteristics are unpredictable, and are expected to differ for every sexually produced progeny plant. *"The claimed invention as a whole may not be adequately described if the claims require an essential or critical feature which is not adequately described in the specification and which is not conventional in the art or known to one of the ordinary skill in the art. For example, consider the claim "A gene comprising*

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SEQ ID NO:1." A determination of what the claim as a whole covers may result in a conclusion that specific structures such as a promoter, a coding region, or other elements are included. Although all genes encompassed by this claim share the characteristics of comprising SEQ ID NO:1, there may be insufficient description of those specific structures (e.g., promoters, enhancers, coding regions, and other regulatory elements) which are also included." MPEP2163

In analyzing whether the written description requirement is met for genus claims, it is first determined whether a representative number of species have been described by their complete structure. (It is not realistic to expect that the "complete structure" of the chrysanthemum plant could be described. Therefore, the inquiry required by this portion of the written description guidelines is interpreted to be whether the phenotypes of all the claimed chrysanthemum plants have been described.) In this case, no hybrids have been described in the specification. The claims encompass chrysanthemums varying in all possible characteristics such as flower color, size, floret number, etc. Thus, the claimed genus obviously encompasses millions of species of hypothetical plants.

Next, then, it is determined whether a representative number of species have been sufficiently described by other relevant identifying characteristics. It is noted that the Applicants intend to deposit the first generation seeds, but the phenotypes have not been disclosed for the plants grown therefrom. Thus, it is concluded that the written description requirement is not satisfied for the claimed genus.

Limiting the claims to deposited plant material, plants grown therefrom and their vegetatively propagated progeny could overcome the rejection.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.

Specifically:

Claims 10-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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Claim 10 is indefinite in its recitation of "seed of claim 9" because claim 9 is drawn to a method. To obviate this rejection, it is suggested that the claim be rephrase to read "seed produced by the method of claim 9" or equivalent expression.

Claim 11 is indefinite because the singular, present indicative "is" is grammatically incorrect and should be changed to the plural – are --. Correction is necessary.

Claim 12 is indefinite in its recitation of "seed of claim 11" because claim 11 is drawn to a method. To obviate this rejection, it is suggested that the claim be rephrase to read "seed produced by the method of claim 11" or equivalent expression.

Claim 13 is indefinite in its recitation of "massive", which fails to clearly set the metes and bounds of the claimed invention. The term "massive" is not defined by the claim, the specification does not provide a standard for ascertaining the requisite degree, and one of ordinary skill in the art would not be reasonably apprise of the scope of the invention. The term could be describing a single large flower or many flowers.

Claim 14 is indefinite because the accession number is not disclosed. Claim 14 is also indefinite in its recitation of "seeds and plants and succeeding generation" because it is unclear if Applicants are referring to individual seeds, plants, or succeeding generation or a combination of all three.

Claim Rejections – 35 USC § 102/103

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a), which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art

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to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 2, 7, 8, 10, 12-14 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Ascher et al (Minnesota Report 242-1997).

Claims 2, 7, 8, 10, 12-14 are drawn to the hybrid seeds of cultivar MN98-E90-15 that includes the following characteristics: shrub-like appearance, massive floral display, cold hardiness in zone 3, and self-pinching. Ascher et al disclose that the *Maxi-Mums* are a "massive, perennial, winter-hardy, shrub-like chrysanthemum" (first page, first paragraph), which is identical to the present claim. The Ascher et al publication describes the chrysanthemum as winter hardy in "zones 3-8" (under Overwintering), "self-pinching" (under Spacing/Pinching), having a "shrub like appearance and a massive floral display" (paragraph 5 and 4, respectively). In claim 14, the recitation "succeeding generation thereof" can be anything and can include all the phenotypic characteristics of Ascher's plant. However, the claims do not particularly point out that the claimed plant possesses any other phenotype, which would distinguish it from Ascher's plants. Thus, the claimed invention is clearly prima facie obvious over, if not anticipated by, the prior art.

By stating that the claimed plant has cultivar MN98-E90-15 in its lineage, Applicants are essentially reciting a process for production of the claimed plant. The courts have approved the use of 102/103 rejections for product-by-process claims. See MPEP 2113.

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Conclusion

No claims are allowed. Claims 1, 3-6, 9 and 11 are free of the prior art, because the prior art did not teach or suggest a new and distinct Chrysanthemum plant designated MN98-E90-15.

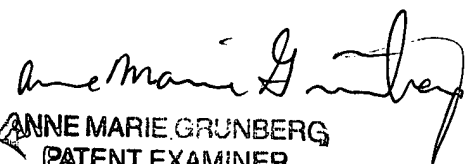
Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Annette H. Para whose telephone number is (703) 308-6327. The Examiner can normally be reached Monday through Thursday from 6:00 am to 4:30 pm.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Bruce Campell, can be reached on (703) 308-4205. The fax number for the group is (703) 305-3014 or (703) 308-4242.

Any inquiry of a general nature or relating to the status of this application should be directed to the Matrix Customer Service Center whose telephone number is (703) 308-0196.

A.H.P


ANNE MARIE GRUNBERG
PATENT EXAMINER